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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MIGUEL A. ESTRADA,
JOSEPH A. RUSSO, and
THOMAS M. SPINE

Appeal 2009-012192
Application 10/731,823
Technology Center 3600

Before HUBERT C. LORIN, ANTON W. FETTING, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1-20. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE and enter a NEW GROUND OF REJECTION, pursuant to our authority under 37 C.F.R. § 41.50(b).

Claim 1 is illustrative:

1. A method for managing membership in a collaborative computing environment community, the method comprising:
 - receiving identification of a selected group of end user persons to invite to join the collaborative computing community;
 - evaluating the selected group to identify one or more invitees there from;
 - inviting the one or more identified invitees; and
 - receiving an indication from one or more invitees that the invitee wishes to join the community.

Appellants appeal the following rejection:

1. Claims 1-20 under 35 U.S.C. § 102(e) as anticipated by Hatscher (US 2004/0122693 A1; Jun. 24. 2004).

ISSUE

Does Hatscher describe, expressly or inherently, a process comprising “receiving an indication from one or more invitees that the invitee wishes to join the community” ?

Also, given their broadest reasonable construction in light of the Specification as they would be interpreted by one of ordinary skill in the art, are the processes recited in claims 1-7 abstract ideas?

FACTUAL FINDINGS

We rely on the Examiner's factual findings stated in the Answer (Answer 3-4). The Examiner cited claims 13 and 14 of Hatscher as describing the claim step "receiving an indication from one or more invitees that the invitee wishes to join the community". Answer 4. Claims 13 and 14 of Hatscher read as follows:

13. The method of claim 11 further comprising notifying people about the existence of a community including that they [have] been identified as potential member[s] of the community.

14. The method of claim 11 further comprising notifying a member of the community in response to an updated list of members indicating potential new members to the community.

ANALYSIS

Process claims 1-7

The Appellants argue that Hatscher does not describe the step of "receiving an indication from one or more invitees that the invitee wishes to join the community" (claim 1). We agree. The Hatscher disclosure relied upon (see *supra*) describes notifying people but does not expressly describe their response to the notification. While it is possible that the notified people may indicate that they wish to join the community, it is equally possible that they may not. It does not necessarily follow that when one notifies people that one would "receiv[e] an indication from one or more invitees that the invitee wishes to join the community." Accordingly, Hatscher does not inherently describe the claim step at issue. "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Hansgirg v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939), quoted

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in *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991). It is well settled that in order for the examiner to establish a *prima facie* case of anticipation, each and every element of the claimed invention, arranged as required by the claim, must be found in a single prior art reference, either expressly or under the principles of inherency. *See generally, In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). Since that has not been done here, the rejection is reversed.

Computer-readable storage medium claims 8-14 and system claims 15-20

The Examiner's reasoning focuses entirely on the steps of the claimed process. However, claims 8-14 are not process claims. System claims 15-20, for example, are apparatus claims. "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990). Accordingly, a *prima facie* case of anticipation has not been made out in the first instance for the subject matter of these claims.

NEW GROUND

We will enter a new ground of rejection of claims 1-7 under 35 U.S.C. § 101 because they claim an abstract idea.

PRINCIPLES OF LAW

The law in the area of patent-eligible subject matter for process claims has recently been clarified by the Supreme Court in *Bilski v. Kappos*, 130 S. Ct. 3218, No. 08-964, 2010 WL 2555192 (U.S. June 28, 2010). The

Court held that the term “process” as used in § 101, does not categorically exclude business methods. *Id.* at *9.

The Court is unaware of any argument that the “ordinary, contemporary, common meaning,” *Diehr, supra*, at 182, of “method” excludes business methods. Nor is it clear how far a prohibition on business patents would reach, and whether it would exclude technologies for conducting a business more efficiently.

“At the same time, some business method patents raise special problems in terms of vagueness and suspect validity.” *Id.* (citing *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 397 (2006)) (Kennedy, J., concurring).

In searching for a limiting principle, this Court’s precedents on the unpatentability of abstract ideas provide useful tools. See *infra* 12-15. Indeed, if the Court of Appeals were to succeed in defining a narrower category or class of patent applications that claim to instruct how business should be conducted, and then rule that the category is unpatentable because, for instance, it represents an attempt to patent abstract ideas, this conclusion might well be in accord with controlling precedent.

Id.

DISCUSSION

Claims 1-7 are drawn to business methods. Taking claim 1 as representative, the broadest reasonable construction of the claimed process in light of the Specification as it would be interpreted by one of ordinary skill in the art is that it provides a series of instructions that do no more than receive one type of information², evaluate the information, invite, and

² The “type” of information the claimed process uses limit the claimed subject matter only in terms of the content of the information. They are properly characterized as nonfunctional descriptive material. In the context of prior art rejections, a distinction over the prior art based on nonfunctional

receive another type of invitation from an invitee. In effect, the process claimed explains a method for identifying persons to invite and who wish to join a community; *i.e.*, “a collaborative computing environment community” (claim 1).

Accordingly, as claimed, the process provides nothing more than vague instructions in how to identify persons to invite and who wish to join a community. That is, the claimed process proposes following a simple formula for identifying a person likely to join a community: receive information, evaluate, invite, and the invitee indicates if he/she wishes to join.

We now turn to the question of whether the claimed process subject matter is patent-eligible under 35 U.S.C. § 101. Various factors must be considered and weighed when analyzing claims as a whole before reaching a conclusion on patent subject matter eligibility.

descriptive material is patentably inconsequential. *See In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004) where, in the context of a prior art rejection, the court held that attaching instructions to an otherwise known product did not render the product patentable over the prior art. *See also In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability) and *Ex parte Mathias*, 84 USPQ2d 1276 (BPAI 2005) (non-precedential) (Federal Circuit Appeal No. 2006-1103; WL 2433879, affirmed without written opinion Aug. 19, 2006) (patentable weight need not be given to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate). We see no reason why recitations of nonfunctional descriptive material should not be similarly treated as inconsequential in the process of determining whether claimed subject matter is statutory under 35 U.S.C. § 101.

The factors relevant in this case are the lack of recitations in the claims to a machine or transformation and that the claims are mere statements of a general concept.

There is no recitation in the claims of a machine, expressly or inherently.

There is no recitation of a transformation, expressly or inherently.

As we have reasonably broadly construed it, the subject matter of claim 1 is made up of mere statements of the general concept of identifying and inviting a person to join a community and receiving a positive indication. The vague instructions listed in the claim are disembodied and do no more than instruct how business should be conducted; that is, to invite a person to join a community and receive a positive indication. The claim covers any use of the concept of identifying and inviting a person to join a community and receiving a positive indication, known and unknown. The instructions could be performed by any machine, existing or future-devised. Furthermore, the process as claimed could be accomplished by human activity alone, including through mental processes. In the words of *Gottschalk v. Benson*, 409 U.S. 63, 72 (1972), the claimed processes “would wholly pre-empt the [identifying and inviting a person to join a community and receiving a positive indication] and in practical effect would be a patent on the [concept] itself.”

For the foregoing reasons, based upon consideration of all of the relevant factors with respect to claims 1-7 as a whole, claims 1-7 are held to claim an abstract idea and are therefore rejected as ineligible subject matter under 35 U.S.C. § 101.

DECISION

The Examiner erred in rejecting claims 1-20 under 35 U.S.C. § 102(e) as anticipated by Hatscher therefore we reverse the Examiner's 35 U.S.C. § 102(e) rejection.

We also enter a new ground of rejection of claims 1-7 under 35 U.S.C. § 101 because they claim an abstract idea.

Since we have entered a new rejection, our decision is not a final agency action. 37 C.F.R. § 41.50(b) provides that, “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b) also provides that the Appellant, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 C.F.R. § 1.197 (b)) as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ...
- (2) Request rehearing. Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record ...

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REVERSED; 37 C.F.R. § 41.50(b)

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